

Claim 60, line 9 after the language "a" insert the language  
-rigid-.

Claim 60, line 10 delete the language "means for moving" and  
the language "out". After the language "drawer" insert the  
language -capable of moving out-.

Claim 63, line 2 replace the language "biasing" with the  
language -urging-.

REMARKS

As an initial matter, Applicant would like to thank the examiner for the help given in prior applications commonly owned with the present application and for the attention given to the present application. Each of the objections and rejections raised in the Office Action mailed October 12, 1999 either have been addressed above or will be addressed below.

Rejections under 35 U.S.C. § 112

Claims were rejected as being indefinite and/or not disclosed in the drawings. As the following discussion will show, the amended claims and substitute drawing sheets have remedied any defect, and the claims are fully supported by the drawings.

The Office Action asserts that the specification at page 59, line 11 is unclear. The specification refers to numeral 362,

which was not shown in Figure 22. Applicant submits that the submission of the substitute drawing sheet containing this numeral overcomes this objection.

Claim 45 was rejected because the conductors 368 of Figure 22 are allegedly not clearly shown as located in the recess. The specification has been amended to make it clear such conductors are located in the recess. Applicant does not believe a change to the figure is necessary, but will make such a change with the submission of formal drawings, if so required.

Claims 46-58 were rejected as being allegedly drawn to a nonelected species. As the following discussion will show, the features of the claims are present in the appropriate figures and the claims read on the elected species. Applicant submits that these claims should now be allowed.

Claim 46 was rejected as the drawing allegedly fails to show the pivoting cover and pivoted clip holder attached to the communications card, the clip holder having an aperture to receive a clip. These features are present in Figure 22. The pivoting cover is shown as 362 in the substitute drawing sheet, the clip holder is shown at 366, and these structures pivot around the pin 364. Ledge 366 forms an aperture in which the bias clip 12 is engaged upon insertion of the RJ plug into the recess.

Claim 48 was rejected because the drawing allegedly fails to show "biasing means." The amendment to the specification, and analogous change on substitute Figure 22, now overcomes this rejection.

Claim 49 was rejected because the drawing allegedly fails to disclose the pivotal attachment point. This point is shown in Figure 22, at numeral 364 as the pin 364, around which the pivoting cover 362 pivots.

Claim 52 was rejected as the drawing fails to disclose a pivotally attached clip holder and clip holder aperture. The claim has been amended to more particularly point out what Applicant believes to be the invention and thus overcome this rejection.

Claim 53 was rejected as the drawing allegedly fails to disclose the V-shaped structures recited in the claim. The amended claim is supported by Figure 23. Moreover, the proposed amendment to Figure 23 provides very clear support for the claimed subject matter. For example, if a cross section of the drawer structure (376A) is taken parallel to the axis of retraction, the V-shaped structure which accommodates the RJ plug becomes apparent. One side of the "V" is the structure which contacts the "bottom" of the RJ plug, where the "top" of the plug is surface where the clip 12 is attached. The other side of the "V" structure is the structure adjacent to conductors 382

provided in the drawer which contact the "wire presenting end" of the RJ plug.

Claim 55 was rejected as the drawing allegedly fails to disclose the pivotal attachment point. Claim 55 has been amended to remove this language, and the attachment of the drawer adjacent to the edge of the first end of the card (as now recited in the amended claim) can be seen in Figure 23.

Claim 63 was rejected as the drawings allegedly fail to disclose the means for biasing the bottom. This claim has been amended as suggested in the Office Action to replace the term biasing with the term urging. Structure corresponding to a means for urging the bottom to a compact configuration are disclosed at Figure 24A as numeral 404 as the bevel to urge the drawer into the compact configuration when retracted.

Claims 45-58 and claims 60-63 were rejected under 35 U.S.C. § 112, second paragraph as being indefinite. The drawings which show the structures recited in these claims were objected to for failing to show the claimed features. The substitute drawings, amendments to the specification and claims, and prior discussion showing where these features are shown in the drawings clarify the meaning of the terms used in the claims, and demonstrate clear basis in the as-filed drawings. Proper basis for claim language is now clearly and explicitly provided in the

specification. Applicant respectfully submits these rejections should be withdrawn on entry of this Amendment.

Rejections under 35 U.S.C. § 102 (b) and 35 U.S.C. § 103 (a)

The claims have been rejected as anticipated by or obvious over prior art. The following discussion will show how the claims are not disclosed in, or taught by, the prior art. Before distinguishing the relied upon references, it would be well to briefly review the appropriate standard for determining patentability under Section 103. Under Section 103, it is necessary to determine whether a *prima facie* case of obviousness is present.

The PTO has the burden under section 103 to establish a *prima facie* case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.

In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988) (citations omitted).

Moreover, a *prima facie* case of obviousness is not established when combining references unless the relied upon references contain some "teaching suggestion" or "incentive" supporting the combination. In re Geiger, 2 U.S.P.Q.2d 1276, 1278 (Fed. Cir. 1987) ("Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive

supporting the combination.") citing ACS Hospital Systems, Inc. v. Montefiore Hospital, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984).

In establishing a *prima facie* case of obviousness, it is improper to "use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." Id. at 1600. Rather, "[t]he test is whether the claimed invention as a whole, in light of all the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made." Connell v. Sears, Roebuck & Co., 220 U.S.P.Q. 193, 199 (Fed. Cir. 1983).

When making a rejection under 35 U.S.C. § 103 there are three fundamental areas which are required, under 37 C.F.R. § 1.106 and M.P.E.P. § 706.02, to be considered. First, any rejection must set forth the differences between the claims and the prior art. Second, any proposed modification of the applied references necessary to arrive at the claimed subject matter should be set out. Third, there must be an explanation why any such proposed modifications would be obvious. Keeping this standard for patentability under Section 103 in mind, the substance of the relied upon references will be discussed in relation to the independent claims now pending herein.

The independent claims will be addressed for the rejections before the dependent claims, as the allowance of the independent

claims will also determine the allowance of most of the dependent claims.

Claims 44-63 were rejected over Aldous alone or in view of Okada. There was no showing anywhere in the relied upon art of a suggestion to combine teachings set forth in these references. Claim 44 has been canceled rendering this rejection moot as to that claim. Claims 45 and 46 teach features not found in either of these references. Neither Aldous or Okada teaches the pivoting cover recited in the claims and shown in the preferred embodiments of the invention. Instead, Aldous teaches a connector where the recess may be in a retractable section, with a pivoting clip holder, it does not show or teach a pivoting cover as required by the claims. Okada teaches a connector with a movable bottom, yet Okada also does not feature the pivoting cover for the recess as required by the claims. As claim 46 is not anticipated or obvious over these references, the dependent claims should also be allowed. Applicant respectfully submits that this rejection to claims 45-51 is improper and should now be withdrawn.

*Not So*      Claim 52 also recites features not taught or suggested by Aldous or Okada. As amended, the drawer in claim 52 has a V- shaped cross section with a clip holder formed on the drawer (see the remarks provided above regarding support for the V-shaped cross section). Aldous instead teaches a retractable connector

without a V-shaped cross section, and in the pertinent embodiment shown in the figures of Aldous, the clip holder consists of a stirrup which pivots into the recess upon retraction, which is separate from the any drawer-type structure and cannot be formed on any structure which corresponds to a "drawer" as required by the claim language. The remaining claims dependent on claim 52 also all include this feature. Applicant respectfully submits that this rejection of claims 52-58 is improper and should be withdrawn.

Claim 59 has been amended to reflect that the claim is now limited only to a communications card which meets the PCMCIA Type III standard, and that the recess is formed by the walled structure of the drawer recited in the claim. This recited structure is not disclosed or suggested in either the relied upon Aldous or Okada references. Aldous discloses a connector in which the plug is left exposed to the surrounding environment when inserted and when in contact with the conductors found on the card of Aldous. The preferred embodiment of the present invention including the structures recited in claim 59 encloses the wires on the plug within the walled structure of the drawer. This claimed structure prevents the user of the embodiment of the present invention from contacting the conductors and potentially receiving an electrical shock. Okada teaches a connector with a movable bottom, not a drawer in which the walls enclose the plug

as recited in the claim. Further, the figures of Okada show a card substantially thinner than the PCMCIA Type III standard now recited in claim 59. Okada Figure 2 shows its card is substantially thinner than the inserted RJ plug and far thinner than the claimed Type III standard. Applicant respectfully submits that this rejection of claim 59 is improper and should be withdrawn

As amended claim 60 includes features not taught or suggested in Aldous or Okada. The stirrup of Aldous is functionally and structurally different from the "bottom" structure recited in claim 60. Figure 24A shows that, when an RJ plug is inserted into the recess, the electrical conductors (398 in Figures 24A&B) and the electrical contacts (20 in Figures 2&3) are covered by the structure of the recess and the rigid bottom.

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The stirrup of Aldous leaves these electrical contacts exposed to the surrounding environment. Such a structure fails to protect the user from the risk of electrical shock, and thus cannot be sold in some jurisdictions. Thus, the differences between the claimed invention and the device disclosed in the Aldous reference are differences having important commercial impact in the marketplace. Moreover, Okada fails to disclose any type of sliding drawer. There is no suggestion in either Aldous or Okada to combine their teachings. Moreover, even if the teachings of the Aldous and Okada references are combined, the claimed

invention does not result. As claims 61-63 depend from claim 60 the discussed features are also present in these dependent claims. Applicant respectfully submits that this rejection of claims 60-63 is improper and should be withdrawn

Claims 42-67 have been rejected over Beckham alone or in view of Okada. There is no motivation or suggestion to combine the teachings of these references. Claim 42 has been canceled rendering this rejection moot as to it. Claim 43 adds the subject matter directed to the means for conveying a communications signal comprising a cord and means for attaching the cord to a portable phone. Beckham discloses attachment to phone lines and there is no mention of portable phones in Beckham or in Okada. Applicant respectfully submits that this rejection to claim 43 is improper and should be withdrawn.

As discussed above claims 45 and 46 teach the feature of a pivoting cover which is not disclosed or suggested in Aldous or Okada. This claimed structure is also not disclosed or suggested in Beckham. Beckham Figure 24 discloses a pivoting stirrup 210 which is above the recess for plug insertion. This stirrup is different from the claimed pivoting cover. The connector shown in Beckham is retracted into the recess by sliding, when the connector is retracted the stirrup pivots into the recess and is also retracted. The pivoting cover of claims 45 and 46 is pivoted to cover and retract the recess. The pivoting cover is

thus separate from a pivoting clip holder. Applicant respectfully submits that this rejection to claims 45-51 is improper and should be withdrawn.

Claims 52-63 were rejected as being anticipated by Beckham Figures 15-22, with Beckham being applied in a fashion similar to the way Aldous was applied to the claims. The prior discussion of why the pertinent claims are allowable over the Aldous and Okada references similarly applies in the case of the Beckham reference. The additional Beckham Figures 30-34 teach a connector which still exposes the wires of the inserted RJ plug to the surrounding environment. Since the structure represented in Beckham at 252 (Figure 31 in Beckham) acts a stop, but fails to completely enclose the plug conductors, it is structurally and functionally very different from the movable bottom recited in claims 60-63. Applicant respectfully submits this rejection is improper and should be withdrawn.

Claims 64-67 have been rejected in view of Beckham alone or with Okada. Again, there has been no showing of any suggestion to combine the teachings of these references. These claims present structures not taught or suggested in the references. Claim 64 is directed to a communications card having a first and second jaw on the end of the communications card. When these jaws are extended from the card they form a recess into which the RJ plug is inserted. Beckham fails to teach or even suggest this

*64*

feature. Beckham Figures 28-36 teach drawers that are extendable from the card. Once these drawers are extended, the their components can be pivoted into position to form a recess for plug insertion. Even if these structures of Beckham are considered "jaws," they are functionally and structurally different from the structures of claim 64. The structures shown in Beckham are pivoted open, or unfolded, after the drawer is extended and are closed for retraction, whereas the jaws recited in claim 64 are separately provided on the end of the communications card and extending the jaws creates the recess, not extension followed by unfolding of a drawer mechanism as taught by Beckham. Thus, Applicant respectfully submits that this rejection to claims 64-67 is improper and should be withdrawn.

Claims 45-59 and 64-67 have been rejected over Mitani. Claims 45 and 46 disclose features that are not taught in Mitani. Mitani teaches a connector which is stowed in a recess or extended for use. The connector of Mitani lacks the feature of a pivoting cover required by claims 45 and 46. Mitani Figures 5 and 6 teach a connector which is shown in the stowed position in Mitani Figure 10. When stowed, the connector of Mitani is simply pushed into the recess. The structure taught in Mitani cannot be read as pivotal covers as they do not pivot to cover the recess. Mitani Figure 1 also fails to teach the claimed structure. The pivotal drawer in Mitani Figure 1 is likewise stowed in the

recess, while the drawer itself pivots when extended, it is not pivoted to open and close the recess as is the pivoting cover of claims 45 and 46. The claimed feature is present in the dependent claims as well. Thus, Applicant respectfully submits that this rejection to claims 45-51 is improper and should be withdrawn.

Claims 52-59 include features not disclosed in Mitani. Claim 52 includes a drawer positioned on the end of a data utilization device. While the Mitani Figure 1 appears at first glance to provide a "drawer," Mitani's specification at column 4, lines 26-36 discloses that Figure 1 discloses a jack capable of being stowed in the recess, actually similar to the later Mitani Figures, and no drawer structure is disclosed or taught. The dependent claims 53-58 all include the drawer structure and thus are also all allowable. Independent claim 59 includes further subject matter directed to a sliding drawer. For the reasons stated above, Applicant respectfully submits that this rejection of claims 52-59 is improper and should be now withdrawn.

Claims 64-67 also claim structures not taught or suggested in Mitani. The Mitani beak-like jack is stowed in a recess from which it is extended for use. The Mitani structure has flexible members to allow it to conform to the recess, when stowed the entire jack simply pushed inside the recess. Thus, the Mitani reference fails to cover the recess for plug insertion, and

leaves the conductors semiexposed to the outside (see Mitani Figure 10). In contrast, claim 64 requires a jack where the jaws are separate members adjacent to first end of the card, forming the recess for receiving the RJ plug between the jaws, when the separate members are extended. The claimed connector is thus disassembled when the separate members are retracted, protecting the conductors and closing the recess. Thus, Applicant respectfully submits that this rejection of claims 64-67 is improper and should be withdrawn.

Claims 34-43 have been rejected over Aldous in view of Gargiulo, Kakinoki and Mitani. There has been, however, no showing of any suggestion in the references to combine the teachings of these references. Claims 34, 39 and 40 all include subject matter directed to having a first side which is not substantially greater than 10.5mm. The combination of these references clearly teach away from the combinations set forth in these claims. For example, the structure represented at 52 in Aldous (which is included as a figure of prior art) shows a Type I or Type II card and thus teaches away from the Type III card now set forth in claims 34, 39 and 40. The structure represented at 52 in Aldous is, to one skilled in the art, teaches a connector which fall outsides the recitation of these claims. Gargiulo also teaches away from the combination set forth in the claims. Gargiulo discloses a card with a retractable type

connector at Figure 3 as prior art. In the Gargiulo's specification at column 6, lines 59-64, it teaches the complexity of a retraction connector and the space it consumes inside a card make it less desirable than using a nonretractable connector in a separate plug. Furthermore, the connector plug 84 of Mitani suffers a problem similar to that suffered by selected devices shown in Aldous, that the plug in Mitani is wider than a the card disclosed therein (81 in Figure 13 of Mitani) by design, having a trapezoidal shape which widens away from the connection to the card 81. The connector plug 84 of Mitani also contains a length of cord wound inside it. It thus would also fall outside the Type III subject matter included in Applicant's pertinent claims. The Kakinoki reference at 1 (Figure 1 in Kakinoki) discloses a boxlike body which also acts a connector plug. Being substantially wider than the card (which one skilled in the art would perceive as having a thickness equivalent to a Type I or Type II card in view of the size of the RJ receptacle 12 in Figure 1) and thus also teaches away from the claims which include Type III subject matter. Even if all of the teachings of the cited references are combined, the resulting hypothetical device would fall outside the requirements of these claims. Moreover, for the reasons provided above, the teachings of the cited references actually teach away from the claimed invention.

Thus, Applicant respectfully submits that this rejection of claims 34-43 is improper and should be withdrawn.

Claim 45 was rejected over Gargiulo. As amended, claim 45 includes features not found or suggested in Gargiulo. The part represented in Gargiulo at 433 (shown in Figure 4 in Gargiulo) is a hinged adapter which is plugged into the end of the PC card and can be folded against the side of the computer when not in use. When folded, the part 433 is not enclosed but remains on the outside of the card and computer, further it leaves an opening into the recess of the connector exposed (see Gargiulo figure 5). In contrast, the recess set forth in claim 45 is enclosed within the PC card when the pivoting cover is closed, protecting both the recess and the entire connector within the card. Applicant respectfully submits that this rejection to claim 45 is improper and should be withdrawn

Claims 34-45 and 59-63 were rejected over McDaniels. Claims 42 and 44 have been canceled rendering this rejection moot as to these claims. As amended, claims 34-37 require the card to have a thickness between about 8 mm to about 10.5 mm. Claim 38 adds the further subject matter that the device comprises a PCMCIA Type III compliant communications card. Figures 6 and 7 of McDaniels show a card which is substantially thinner than the PCMCIA Type III standard. The McDaniels specification at column 1, lines 46-47 only provides support for a device with a

thickness of up to 8 mm, for example the PCMCIA Type II standard. This is too thin to comply with the Type III standard, and lies outside the scope of amended claim 34. Similarly amended claims 39 and 40 are for a device between 8 mm to 10.5 mm, placing it outside the teachings of the McDaniels reference. Applicant respectfully submits that this rejection to claims 34-43 is improper and should now be withdrawn in view of the amendment to these claims.

As amended claim 45 discloses features not taught by McDaniels, either alone or in combination with any other references now of record. McDaniels Figure 6 fails to disclose a pivoting cover, and McDaniels Figures 12 and 13 disclose a pivoting cover, and McDaniels Figures 12 and 13 disclose a pivoting cover which is structurally and functionally different from that required by claim 45. When closed the McDaniels cover is not enclosed inside the card, and a close examination of the McDaniels figures reveals that a "gap" is left when the RJ plug is removed, exposing the recess to the environment. The structure recited in claim 45 encloses the recess inside the card and eliminates this gap. Thus, Applicant respectfully submits that this rejection to claim 45 is improper and should be withdrawn.

As amended claims 60-63 disclose features not found in McDaniels. The McDaniels reference at 114 (see McDaniels at Figure 2) is an expandable member stretched across the bottom of

the recess. This member is an elastic membrane which stretches upon insertion to cover the exposed portion of the wires of the RJ plug. Claim 60 has been amended to reflect that the claimed invention has a rigid bottom which moves vertically, not an elastic bottom which stretches. This feature is also present in the dependent claims 61-63. As the "bottoms" of the claimed device and the McDaniels device are very different, Applicant respectfully submits that this rejection to claims 60-63 is improper and should now be withdrawn in view of the amendment made to claim 60.

Nonstatutory double patenting rejections

Claims 44-67 were rejected under the judicially created doctrine of double patenting over McDaniels (U.S. Patent No. 5,411,405) as alleging that these claims, when allowed, would inappropriately extend the right to exclude already granted in McDaniels.

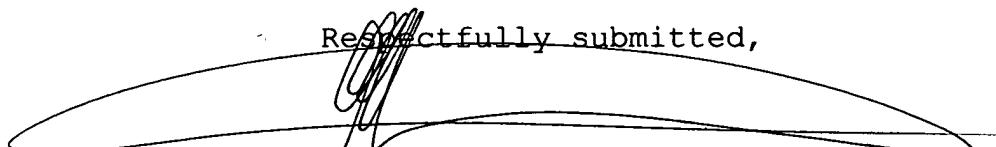
As the previous discussion of the McDaniels reference shows, the remaining claims are patentable over McDaniels as they are neither anticipated by, or obvious in view of, McDaniels. Since the claims are allowable over the McDaniels reference as prior art, it follows that the McDaniels reference cannot be used as the basis of an obvious-type double patenting rejection. The claims now pending are distinct inventions which will not

inappropriately prolong the patent term provided by the McDaniels reference.

The Commissioner is hereby authorized to charge any fee or to credit any overpayment in connection with this paper to Deposit Account No. 50-0836.

In view of the forgoing, it is respectfully submitted that all of the remaining claims now present allowable subject matter. Thus, favorable action concerning these claims is respectfully requested. If any impediment to the allowance of these claims remains after entry of this Amendment and consideration of these remarks the Examiner is invited to initiate a telephone interview with the undersigned.

DATED this 12 day of January, 2000.

  
Respectfully submitted,

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